

## REMARKS

Entry of this Amendment and reconsideration are respectfully requested in view of the amendments made to the claims and for the remarks made herein.

Claims 1-11 and 16-20 are pending and stand rejected.

Claim 1 is the sole independent claim.

Claim 1 has been amended.

Claims 1-11 and 16-20 stand rejected under 35 USC 103(a) as being unpatentable over Soane (USP no. 6,570,714) as evidenced by Dealy (Structure and Rheology of Molten Polymers ...).

With regard to the rejection of claims 1-11 and 16-20 under 35 USC 103(a) as being unpatentable over Soane as evidenced by Dealy, applicant respectfully disagrees with and explicitly traverses the reason for the rejection. However, in the interest of advancing the prosecution of this matter, independent claim 1 has been amended to recite more specifically the characteristics of the polymer as being selected as one having a low glass-to-rubber transition temperature,  $T_g$ , not lower than 50 degs. C. and a low weight-average molecular weight,  $M_w$ . No new matter has been added. Support for the amendment may be found at least on page 6, lines 3-13.

Soane discloses a method of making a composite article that includes the steps of placing a semi-solid like polymerizable composition in contact with a substrate, compressing or heating the resulting semi-solid/substrate between tow mold halves, exposing the semi-solid/substrate to a source of polymerizing energy (UV, see col. 8, line 21). The composite article comprises a substrate and at least one layer or superstrate of a cured resin permanently bonded to the substrate, the cured resin being a polymer blend of a polymerized reactive plasticizer and a dead polymer or a polymerized reactive plasticizer alone.

In rejecting the claims, the Office Action refers to the dead polymer of Soane as being comparable to the thermoplastic polymers recited in the claims.

However, Soane fails to provide any disclosure regarding a transition temperature or a molecular weight of the material.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met, 1. there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings, 2. there must be a reasonable expectation of success; and 3. the prior art reference must teach or suggest all the claim limitations.

The Court in KSR v. Teleflex (citation omitted) has held that the teaching, suggestion and motivation test (TSM) is merely to be used as a helpful hint in determining obviousness and a bright light application of such a test is adverse to those factors for determining obviousness enumerated in the Graham v. John Deere (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness) (citation omitted).

In this case, Soane cannot be said to render the subject matter recited in claim 1 obvious as Soane fails to disclose a material element recited in the claim.

For the amendments made to the claim 1, applicant submits that claim 1 includes subject matter not disclosed by Soane and, hence, claim 1 is not rendered obvious by the cited reference.

With regard to the rejection of the remaining claims under 35 USC 103, these claims depend from independent claim 1 and, hence, each of the remaining claims is also allowable by virtue of its dependency upon an allowable base claim.

For the amendments made to the claims and for the remarks made, herein, applicant submits that the reason for the rejections of the claims has been overcome and respectfully requests that the rejections be withdrawn and a Notice of Allowance be issued.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

Should the Examiner believe that the disposition of any issues arising from this response may be best resolved by a telephone call, the Examiner is invited to contact applicant's representative at the telephone number listed below.

No fees are believed necessary for the timely filing of this paper.

Date: December 13, 2009

Respectfully submitted,  
Michael E. Belk, Reg. No. 33357  
/Carl A. Giordano/

By: Carl A. Giordano  
Attorney for Applicant  
Registration No. 41,780

**Mail all correspondence to:**  
Michael E. Belk, Esq.  
US PHILIPS CORPORATION  
P.O. Box 3001  
Briarcliff Manor, NY 10510-8001  
Phone: (914) 333-9643  
Fax: (914) 332-0615

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

The undersigned hereby certifies that this document is being:  
[ ] Transmitted electronic by the currently available EFS system;  
[ ] Transmitted by facsimile to 571 273 8300;  
[ ] Placed with the US Postal Service with First Class postage attached to the address indicated above;  
on December \_\_\_\_\_, 2009.

\_\_\_\_\_  
Print Name

\_\_\_\_\_  
Signature